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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,881	12/05/2003	Jeffrey Jennings Krueger	KC-19,203	9190

7590 09/30/2005

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EXAMINER
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ZEMEL, IRINA SOPJIA

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 09/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/729,881

Applicant(s)

KRUEGER ET AL.

Examiner

Irina S. Zemel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                                                     |                                                                                         |
|-----------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                                         | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                                | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/24/05: 5/10/04</u> | 6) <input type="checkbox"/> Other: _____                                                |

## DETAILED ACTION

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-39 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-39 of copending Application No. 11/218825. Although the conflicting claims are not identical, they are not patentably distinct from each other because the referenced '825 application claims the same foams as the instant application and additionally claims some physical properties of the foams. Since the foams claimed in the instant application and the referenced '825 application are made from substantially the same components via substantially the same process, it is reasonably believed that the foams claimed in the instant application inherently exhibit the claimed properties, thus the foams claimed in the instant and the referenced application are obvious over each other..

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-39 rejected under 35 U.S.C. 103(a) as being unpatentable over US patent 6,268,046 to Miller et al., (hereinafter "Miller) in combination with Landrock's Handbook of Plastic Foams, page 308 (hereinafter "Handbook") or US Patent 6,093,751 to Federico et al., (hereinafter Federico").

Miller discloses low density absorbent thermoplastic foams comprising, as a base resin, a polystyrene resin, and a plastisizing agent, such as wax, or various low molecular weight polymers. See illustrative example 1 and column 6, line 66 to column 7, line 17. The reference expressly discloses that elastomeric rubbers such as diblock or triblock SBS, SEBS (Kratons) can be incorporated in the foams in the amounts of up to 10 %. See column 7, lines 18-38. The reference does not expressly disclose the amount of diblock rubber per total amount of elastomer, but as discussed above, expressly lists both diblock and triblock elastomers as suitable elastomers. Thus, use of both elastomers in any amount would have been obvious with reasonable expectation of adequate results absent showing of unexpected results that can be attributed to the claimed amounts of diblock rubber.

The foams are produced by extruding the foamable mixture.

The reference, while expressly listing stabilizers as useful additives (see column 7, line 52) does not expressly disclose surfactants (or specifically claimed types of surfactants). Addition of surfactants to soft foams is notoriously known in the art as stabilizing agents and, thus, it would have been obvious to add surfactants to foamable compositions disclosed in Miller. This position is supported by the teachings of the Handbook, expressly stating that surfactants are commonly used for stabilization of foams, or by teachings of Federico, which expressly states that addition of such, increases absorbency of the foam. See column 3, lines 1-15. Therefore, addition of surfactants to the foamable compositions disclosed by Miller would have been obvious to realize the known advantages that such surfactants bring into the foams such as stabilization and better absorbency. The foams are produced by extruding the foamable mixture.

The Miller reference does not expressly address that claimed physical properties of the foams (with the exception of foam density which can be as low as 0.045 g/cm<sup>3</sup> as per column 8, line 54), however, since the claimed foams and the foams disclosed by Miller (as modified in view of the secondary references) are substantially identical, it is believed that the disclosed modified foams would inherently exhibit the claimed properties. The burden is shifted to the applicants to provide factual evidence to the contrary.

Claims 1-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Federico in combination with Miller

Federico discloses flexible soft absorbent open cell foams comprising polystyrene and surfactant (non-ionic or mixed). Addition of di- or tri-block copolymers to the compositions of Federico would have been obvious from teachings of Miller who expressly discloses that addition of plasticizers and elastomers (including di-or tri-block elastomers) improves processing of styrene-base foams (as per column 7, lines 1-38 of Miller). See discussion above regarding di-/ tri- block elastomer amounts and ratios.

As in Miller, the Federico reference does not address the physical properties claimed in the instant application, however, as per discussion above, it is believed that the disclosed modified foams would inherently exhibit the claimed properties. The burden is shifted to the applicants to provide factual evidence to the contrary.

Claims 1-3, 7-12, 14-30, 35, 37, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,652,277 to Reedy et al., (hereinafter "Reedy") in combination with the Handbook or Federico.

Reedy discloses open cell foams based on a polystyrene resin that includes block-copolymer rubber and a plasticizer that is obtained by extrusion of foamable compositions (containing all of the above components). See illustrative examples. Addition of surfactants to soft foams is notoriously known in the art as stabilizing agents and, thus, it would have been obvious to add surfactants to foamable compositions disclosed in Miller. This position is supported by the teachings of the Handbook, expressly stating that surfactants are commonly used for stabilization of foams, or by teachings of Federico, which expressly states that addition of surfactants, increases absorbency of the foam. See column 3, lines 1-15. Therefore, addition of surfactants to

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the foamable compositions disclosed by Miller would have been obvious to realize the known advantages that such surfactants bring into the foams such as stabilization and better absorbency. The foams are produced by extruding the foamable mixture.

The Reedy reference does not expressly address that claimed physical properties of the foams (with the exception of foam density which can be as low as 0.045 g/cm<sup>3</sup> as per column 8, line 54), however, since the claimed foams and the foams disclosed by Miller (as modified in view of the secondary references) are substantially identical, it is believed that the disclosed modified foams would inherently exhibit the claimed properties. The burden is shifted to the applicants to provide factual evidence to the contrary.

### ***Information Disclosure Statement***

The references cited by applicants in the IDS and listed on the numerous 1449's that include more than 200 references have been made of record. While the statements filed clearly do not comply with the guidelines set forth in MPEP 2004 regarding both the number of references cited and the elimination of clearly irrelevant art and marginally cumulative information, compliance with these guidelines is not mandatory.

Furthermore, 37 CFR 1.97 and 1.98 do not require that the information be material, rather they allow for submission of information regardless of its pertinence to the claimed invention. Also, there is no requirement to explain the materiality of the submitted references, the cloaking of a clearly relevant reference by inclusion in a long

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list of citations may not comply with Applicant's duty of disclosure, see Penn Yan Boats, inc. V. Sea Lark boats Inc., 359 F. Supp. 948, aff'd 479 F. 2d. 1338.

Applicant is advised that the M.P.E.P. states the following with respect to large information disclosure statements:

*Although a concise explanation of the relevance of information is not required for English language information, applicants are encouraged to provide a concise explanation of why the English-language information is being submitted. Concise explanations (especially those that point out the relevant pages and lines) are helpful to the Office, particularly where documents are lengthy and complex and applicant is aware of a section that is highly relevant to patentability or where a large number of documents are submitted and applicant is aware that one or more is highly relevant to patentability.*

M.P.E.P. § 609. This statement is in accord with dicta from *Molins PLC v. Textron, Inc.*, 48 F.3d 1172 (Fed. Cir. 1995), states that forcing the Examiner to find "a needle in a haystack" is "probative of bad faith." *Id.* at 1888. This case presented a situation where the disclosure was in excess of 700 pages and contained more than fifty references. *Id.* 1888. A cursory glance at the M.P.E.P. also provides more support for this position. In a subsection entitled "Aids to Compliance With Duty of Disclosure," item thirteen states:

*It is desirable to avoid the submission of long lists of documents if it can be avoided. Eliminate clearly irrelevant information and marginally pertinent cumulative information. If a long list is submitted, highlight those documents which have been specifically brought to Applicant's attention and/or are known to be of the most significance. See Penn Yan Boats, Inc. v. Sea Lark Boats, Inc., 359 F.Supp 948 (S.D. Fla. 1972) aff'd 479 F.2d 1338 (5<sup>th</sup> Cir 1974); [Molins]."*



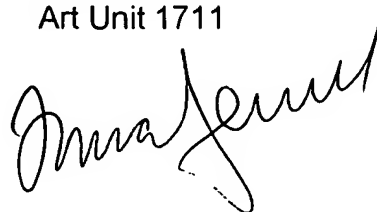
Therefore it is recommended that if any information that has been cited by Applicants in the previous disclosure statement, is known to be material for patentability as defined by 37 CFR 1.56, Applicant should present a concise statement as to the relevance of that/those particular documents therein cited.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irina S. Zemel whose telephone number is (571)272-0577. The examiner can normally be reached on Monday-Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571)272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Irina S. Zemel  
Examiner  
Art Unit 1711



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